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PATENT TRADEMARK OFFICE

Attorney Dkt. No. 6727/0H449

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Application of : HERZBERG et al.

Serial No.: 09/625,006 : Group Art Unit: 3621

Filed : July 25, 2000 : Examiner: Kambiz Abdi

For : MICRO PAYMENT-BASED ADVERTISING

December 9, 2002

Honorable Commissioner of  
Patents and Trademarks  
Washington, DC 20231

RESPONSE TO OFFICIAL ACTION

RECEIVED  
DEC 12 2002  
GROUP 3600

Sir:

In response to an Official Action dated September 9, 2002, applicant submits the following remarks. This application contains claims 1-35, all of which were rejected in the present Official Action. Reconsideration

is respectfully requested.

Claims 15, 16, 20, 27, 28, 33 and 34 were rejected under 35 U.S.C. 102(e) over Messer (U.S. Patent 5,991,740) and over Barber (U.S. Patent 6,157,917). Applicant respectfully traverses these rejections.

Barber describes a method for charging for pay-per-access information on a network. In this patent, Barber proposes to use an "acquirer" to reduce the network bandwidth required in transferring small payments between a payer, a payee and an issuer. In the embodiments described by Barber, the payee is a Web site operator, who offers information for sale; the payer is a computer user who purchases the information from the Web site operator; and the issuer is a service that manages a payer database. The acquirer stores and retrieves information about the payer's account with the issuer, in the form of a dynamic data object, like a cookie, on the payer's computer. The acquirer intercepts the payer's requests for information from the payee's Web site. The acquirer then processes the payer's accounting information using the dynamic data object, and redirects the payer to the payee's Web site to receive the requested information.

Claim 15 in the present patent application recites a method for electronic commerce by a merchant, who offers an item for purchase by a buyer on a page-per-fee basis. An advertiser posts an advertisement for the item, and the buyer may purchase the item by invoking a link in the advertisement. The advertiser then submits an order to the merchant. In response to the order, the merchant conveys the item, via the advertiser, to the buyer. The merchant receives payment from the buyer, while a predefined portion of the purchase price is paid to the

advertiser in consideration for posting the advertisement, in accordance with advertising terms that were defined by the merchant.

In contrast to the method of claim 15, Barber neither teaches nor suggests posting any sort of advertisement, compensating an advertiser, or conveying an item to a buyer via an advertiser. Barber is not concerned with advertisement, and does not use this term (or any related term) anywhere in his patent. The purpose of Barber's "acquirer" is not to advertise anything, but rather to facilitate payment from the buyer ("payer") to the merchant ("payee"). Barber's buyer invokes a link directly on the merchant's site (col. 4, lines 35-38) to purchase the desired information. The buyer does not invoke a link on an advertiser's site, as required by claim 15, nor does the buyer make any active use of a link on a site of the "acquirer." Upon completing the transaction, Barber's merchant transfers the item ("target information") directly to the buyer (see, for example, step 6 in Fig. 1), rather than via the advertiser, as required by claim 15.

Messer describes a data processing system for managing transaction-related information generated on a network, including referral fee accounting for purchases. These functions are performed by a Clearinghouse server, which communicates with merchants and with site owners, who advertise the merchants' products on their Web sites (see Figs. 1 and 2, and col. 5, lines 4-16). Messer is not concerned with page-per-fee purchases of information, as required by claim 15, and makes no mention or suggestion of this type of commerce. Rather, Messer's system is directed to purchase of conventional goods, for delivery not over the network, but by land or air

channels (col. 4, lines 63-65).

Furthermore, in Messer's system, the item purchased by the buyer (the "user") is not conveyed via the advertiser, as required by claim 15, but is rather supplied directly from the merchant to the buyer (as shown in Messer's Figs. 1 and 2). Messer neither teaches nor suggests conveying any sort of item via an advertiser to a buyer.

Thus, applicant respectfully submits that claim 15 is patentable over both Barber and Messer, whether these references are taken alone, as suggested by the Examiner, or even if the references are combined. Even taken together, Barber and Messer fail to teach or suggest all of the features of the invention recited in claim 15. In view of the patentability of claim 15, claims 16-23, which depend from claim 15, are believed to be patentable, as well.

Claim 27 recites a merchant processor for use in electronic commerce, while claim 33 recites a computer software product for use by a merchant. The apparatus and software covered by these claims operate on principles similar to those recited in method claim 15. Therefore, applicant respectfully submits that claims 27 and 33 are patentable over Barber and Messer, as well, for the reasons argued above. In view of the patentability of claims 27 and 33, claims 28, 29, 34 and 35, which depend from either claim 27 or claim 33, are also believed to be patentable.

Claims 1-14, 17-19, 21-26, 29-32 and 35 were rejected under 35 U.S.C. 103(a) over Messer in view of Barber. Applicant respectfully traverses this rejection. Claim 1 recites a method for electronic advertising that includes posting an advertisement for a page-per-fee

item. The item is offered to a buyer for purchase via a link to a network address that is represented in the advertisement by an alias, which conceals the network address from the buyer. When the buyer invokes the link, an order is transmitted to the merchant for supply of the item to the buyer. The alias is useful both in identifying the advertiser to the merchant (page 5, lines 28-30, in the present patent application) and in preventing the buyer from circumventing the advertiser in subsequent purchases (page 6, lines 19-24).

In rejecting claim 1, the Examiner states that Barber teaches the use of an alias. While this assertion may be true, it is not sufficient grounds to render obvious the particular novel use of the alias recited in claim 1. Barber's alias is embedded at the payee's site (i.e., at the merchant's site), and links a payer (buyer) to the acquirer (col. 7, lines 34-36, cited by the Examiner). The acquirer is responsible for handling payment by the buyer, and has nothing to do with advertising the merchant's items. Claim 1, on the other hand, recites the use of the alias at the advertiser's site, in order to conceal the merchant's site. As Barber makes no mention of advertisement, and teaches the use of an alias only at the merchant's site, he cannot reasonably be considered to suggest the use of an alias in an advertisement to conceal the merchant's site. Therefore, applicant respectfully submits that claim 1 is patentable over Messer in view of Barber.

In view of the patentability of claim 1, claims 2-14, which depend from claim 1, are believed to be patentable, as well.

Claim 24 recites an advertising processor, while claim 30 recites a computer software product for

electronic advertising. The apparatus and software covered by these claims operate on principles similar to those recited in method claim 1. Therefore, applicant respectfully submits that claims 24 and 30 are patentable over Messer in view of Barber, as well, for the reasons argued above. In view of the patentability of claims 24 and 30, claims 25-29 and claims 31 and 32, which depend from either claim 24 or claim 30, are also believed to be patentable.

Notwithstanding the patentability of the independent claims in this application, as argued above, applicant believes that the dependent claims in the present patent application recite independently patentable subject matter. In the interest of brevity, applicant will not argue the patentability of all the dependent claims at this point. By way of example, however, applicant notes claim 10, which depends from claim 1, and adds the limitation that the alias used in the advertisement is assigned by the merchant to correspond specifically to a given advertiser. As pointed out above, this feature of the present invention is advantageous in that it allows the merchant to determine the identity of the advertiser based on the alias used.

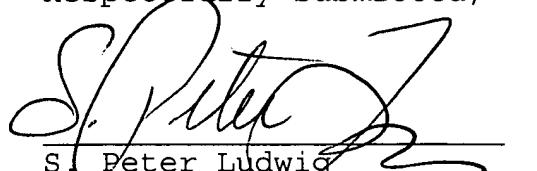
In rejecting claim 10, the Examiner argues that "Barber clearly teaches... that the alias is assigned by the merchant to correspond specifically to the advertiser." Since Barber makes no mention whatsoever of advertisers, it is difficult to understand where such a clear teaching could be inferred from Barber. Furthermore, the aliases used by Barber's payee all refer to the same acquirer. Barber neither teaches nor suggests that multiple aliases might be used to refer to multiple different sites, let alone different

advertisers. The Examiner reasons that "merchants have to be able to identify the web page the user is coming from" as the reason why it would have been obvious, in view of Barber, to assign specific aliases to different advertisers. This reasoning is based on hindsight from the present patent application, however, and has no basis in the cited art. In Barber's paradigm, the user (payer) reaches the merchant's site (payee) directly, and Barber makes no mention of any sort of click-through. Therefore, applicant respectfully submits that even if claim 1 were considered to be obvious, claim 10 is still independently patentable over the cited art.

Applicant has studied the additional references cited by the Examiner and believes that the claims currently pending in the present application are patentable over these references, as well, whether taken individually or in combination with other cited references.

Applicant believes the remarks presented hereinabove to be fully responsive to all of the grounds of rejection and objections raised by the examiner. In view of these remarks, applicant respectfully submits that all of the claims in the present application are in order for allowance. Notice to this effect is hereby requested.

Respectfully submitted,

  
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